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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,253	09/09/2003	Akihisa Nakajima	KON-1822	4123
20311	7590	12/15/2004	EXAMINER	
MUSERLIAN, LUCAS AND MERCANTI, LLP			CHEA, THORL	
475 PARK AVENUE SOUTH			ART UNIT	PAPER NUMBER
15TH FLOOR				1752
NEW YORK, NY 10016				

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/658,253	NAKAJIMA ET AL.
	Examiner Thorl Chea	Art Unit 1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 September 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-6, 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sampei (US Patent No. 6,190,854). Seimpei discloses a material having a thermally developable material having having fluorine surfactant which is a (meth)acrylate polymer which has fluorinate alkyl group on its side chains, and which has a number a layer average molecule weight of not more than 30,000 in terms of standard polystyrene conversion and more preferably from 2,000 to 10,000; the fluorine containing surfactant is incorporate in any of image forming layer, component layer, or the secondary component layer, but preferably a layer provide on the image forming layer side, or in an outermost layer provided opposite of said image forming layer, for example protective layer. See column 5, lines 47-67, column formula (A-a), (A-b), A-1 to A-7; columns 7-13, formulae A-8 to A-65; (meth)acrylate structural unit of the (meth)acrylate polymer having the alkyl group of formulate in columns 15-16, C-1 to C-19; columns 17-18, C-20 to D1-17; Table 1 in column 19, and Example in columns 39-40, Table 2, such as sample 106. The (meth)acrylate structural unit of the (meth)acrylate polymer is considered as hydrophobic group within the meaning of monomer claimed in the present claimed invention. Accordingly the invention as claimed lacks novelty.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkoshi et al (US Patent No. 5,532,121).

See column 10, lines 12-14, column 10, lines 25-26, columns 27-28, claims 1-12; column 11, lines 43-46 which discloses the fluorine surfactant having acrylate group therein and the ethilenically unsaturated portion of monomer of acrylate or methacrylate, and the amount of 0.05 5 to 10 % by weight of the layer. It would have been obvious to the worker of ordinary skill in the art to use the fluorine surfactant having acrylate group therein and the ethilenically unsaturated portion of monomer of acrylate or methacrylate suggested in the Yonshoki et al with a reasonable expectation of getting the reduction of mold.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonshoki et al as applied to claims 1-3, 8-9 above, and further in view of Arimoto et al (US Patent No. 6,475,697). The tin oxide has been known to be used in the electrically conductive layer for photothermographic material and taught in Arimoto et al in column 18, lines 9-22. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the tin oxide taught in Arimoto et al to improve the antistatic property of the material taught in Yonkoshi et al, and thereby provide a material as claimed.

6. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *TM*  
December 7, 2004

Thorl Chea  
Primary Examiner  
Art Unit 1752

